

REMARKS

An excess claim fee payment letter is submitted herewith for two (2) excess independent claims and eleven (11) excess total claims.

Claims 1-31 are all the claims presently pending in the application. Claims 1, 6, and 11-17 have been amended to conform with U.S. patent practice and to define more clearly the features of the present invention. Claims 18-31 have been added to claim additional features of the invention and to provide more varied protection for the invention.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability.

Further, Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claim 17 stands rejected under 35 U.S.C. § 101 because the claimed invention allegedly is directed to non-statutory subject matter. Claims 1-17 stand rejected on prior art grounds.

As for the prior art grounds, claims 1, 3, 4, 7, 8, and 15 stand rejected under 35 U.S.C. § 103(a) over Hagiuda (U.S. Patent No. 5,953,008) and Ito, et al. (U.S. Patent No. 6,453,071; hereinafter "Ito"); claims 2, 5, and 6 stand rejected under 35 U.S.C. § 103(a) over Hagiuda, Ito, and further in view of Hatori (U.S. Patent No. 6,553,382); claims 9 and

10 stand rejected under 35 U.S.C. § 103(a) over Hagiuda, Ito, and further in view of Fukushima, et al. (U.S. Patent No. 6,295,086; hereinafter "Fukushima"); claims 11 and 17 stand rejected under 35 U.S.C. § 103(a) over Hagiuda and Ito; claims 12 and 13 stand rejected under 35 U.S.C. § 103(a) over Hagiuda and Ito; claim 14 stands rejected under 35 U.S.C. § 103(a) over Hagiuda and Ito; and claim 16 stands rejected under 35 U.S.C. § 103(a) over Hagiuda, Ito, and further in view of Pearlman, et al. (U.S. Patent No. 5,764,807; hereinafter "Pearlman").

These rejections are respectfully traversed in the following discussion.

I. STATEMENT OF SUBSTANCE OF THE INTERVIEW

Applicants' Representative would like to thank Examiners Pham and Garcia for courtesies extended in the productive personal interview conducted at the U.S. patent office on March 30, 2004, in which the merits of the represent rejections were discussed.

In the interview, it was agreed that further search would be necessary to overcome the deficiencies of the cited prior art, which fail to contemplate (or teach or suggest) reducing wasting of the memory capacity of the storage medium. It also was agreed that the prior art of record does not appear to teach (or suggest) one of the aspects of the present invention of not duplicating the image for printing a still and/or moving image in order to avoid wasting memory capacity in the storage medium. (See Interview Summary dated March 30, 2004; Paper No. 5.)

The Examiner did not comment on the allowability of the claims at this time, since further search was deemed necessary.

For the Examiner's convenience, and in compliance with M.P.E.P. § 713.04, Applicants submit the following remarks to summarize Applicants' position, as presented in the interview.

II. THE CLAIMED INVENTION

As explained in the interview, the claimed invention is directed to a print designating method and apparatus, and a printing method and apparatus, which may be applied to a digital camera.

In an illustrative, non-limiting embodiment of the present invention as defined by claim 1, a print designating method includes storing, in a print designation file in a recording medium in which a file including image data is stored, print designating information to designate an image to be printed stored in the recording medium. The print designating information includes file specifying information for specifying a subject file including the image to be printed and file type identifying information for identifying whether the subject file includes a moving image file or a still image file. If the subject file includes a moving image file, the print designating information further includes scene specifying information for specifying a subject scene to be printed in the moving image file.

Other exemplary embodiments of the present invention as defined by independent claims 11, 12, and 14-17 also recite similar features.

In conventional devices, the image data of a still image taken from a moving image is stored redundantly on the recording medium with the image data of the moving image, thereby wasting memory capacity of the recording medium on which the image data is stored.

In the claimed invention, on the other hand, the designation of printing from the still image file and the moving image file can be achieved using a single print designation file. That is, by taking out the desired still image scene from the moving image file, the memory capacity of the memory card can be used efficiently since a duplicate still image data does not have to be prepared. Thus, the claimed invention provides a method and device for printing a specific scene of a moving image without redundantly storing (i.e., duplicating), on the recording medium, the image data of the image to be printed, thereby avoiding wasting of the memory capacity of the recording medium (e.g., see Figure 2, page 3, lines 17-23, and page 21, lines 18-22).

III. CLAIM REJECTIONS BASED ON PRIOR ART GROUNDS

A. Claims 1, 3, 4, 7, 8, and 15 stand rejected under 35 U.S.C. § 103(a) as being obvious over Hagiuda and Ito. For at least the following reasons, Applicants respectfully traverse this rejection.

As discussed in the interview, Applicants respectfully submit that the prior art of record fails to disclose storing a print designation file in a recording medium in which a file including image data is stored or, for that matter, that the print designation file designates an image to printed which is stored in the recording medium, or more particularly, that the print designation file designates a still image to be printed which is stored in a moving image file stored in the recording medium.

In the interview, it was agreed that further search would be necessary to overcome the deficiencies of the cited prior art, which fail to contemplate (or teach or suggest) reducing the wasting of memory capacity in the storage medium. It also was agreed that the prior art of record does not appear to teach or suggest one of the aspects of the present invention of not duplicating the image for printing a still and/or moving image in order to avoid wasting memory capacity in the storage medium.

As Applicants' representative explained in the interview, independent claim 1 recites, *inter alia*, "storing, in a print designation file in a recording medium in which a file including image data is stored, print designating information to designate an image to be printed stored in the recording medium" (emphasis added). Accordingly, in Applicants' novel and unobvious invention including the print designation file, the desired still image scene can be taken from the moving image file (i.e., a duplicate still image data file of the image taken from the moving image is not necessary), thereby efficiently using the memory capacity of the recording medium (e.g., a memory card).

In comparison, Applicants respectfully submit that Hagiuda neither discloses nor suggests “storing, in a print designation file in a recording medium in which a file including image data is stored, print designating information to designate an image to be printed stored in the recording medium”, as recited in independent claim 1.

Instead, Hagiuda merely discloses an image data file and an apparatus for editing an image data file, not “a print designation file in a recording medium in which a file including image data is stored”, as recited in claim 1. More particularly, Hagiuda discloses a source file editing apparatus that edits files by displaying the source files as thumbnails on a display screen and controlling the drag-and-drop operation of the thumbnails on the display screen to edit the files (e.g., see Abstract of Hagiuda; col. 4, lines 29-54; Figs. 8-12). However, Applicants respectfully submit that the image data file of Hagiuda is not comparable to (let alone teaches or suggests) the print designation file, as claimed.

Moreover, even assuming *arguendo* that the image data file of Hagiuda would be considered comparable to the image data file which is stored in the recording medium, Hagiuda neither discloses nor suggests (or for that matter even mentions) storing a print designation file in the recording medium, in which a file including image data also is stored, as claimed. Thus, Applicants respectfully submit that Hagiuda neither discloses nor suggests “storing, in a print designation file in a recording medium in which a file including image data is stored, print designating information to designate an image to be printed in the recording medium” as recited in claim 1.

Similarly, Ito's Admitted Prior Art neither discloses nor suggests the claimed "storing, in a print designation file" and therefore does not make up for the deficiencies of Hagiuda.

In the interview, the Examiner alleged that Ito's Admitted Prior Art discloses selecting a desired still image of one from the moving images (e.g., see Ito at column 1, lines 54-67).

However, Applicants submit that, when considered as a whole, Ito still does not disclose or suggest the claimed "print designation file".

Instead, Ito discloses that:

[I]n order to select a desired still image contained in moving images produced with D-CAM 101, the moving image is required to be temporarily stored in the storage device such as a hard disk of PC 103. PC 103 then reproduces moving image data stored in the storage device to select a desired still image (e.g., see Ito at column 2, lines 1-7; emphasis added).

Thus, Ito seems to disclose that the image is reproduced by the PC 103 (i.e., uplicated). Accordingly, Applicants respectfully submit that claim 1 would not have been obvious to a person of ordinary skill in the art at the time of the invention over Hagiuda and Ito, either alone or in combination.

For at least these reasons, Applicants respectfully submit that any combination of Hagiuda and Ito would not arrive at the claimed invention, and therefore, respectfully requests that the Examiner withdraw the rejection of claims 1, 3, 4, 7, 8, and 15 and permit these claims to pass to allowance.

Additionally, Applicants respectfully submit that the Office Action does not establish a reasonable motivation for combining Hagiuda and Ito. For example, the Office Action (at page 4, third paragraph) alleges that it would have been obvious to modify Hagiuda in view of Ito “*to provide an apparatus for editing moving images*” that is “*excellent in terms of portability*” (as allegedly described at col. 11, lines 1-5 of Hagiuda) and “*to prevent errors in editing moving images operation*” (as allegedly described at col. 11, lines 14-25 of Hagiuda).

However, it is noted that the references as a whole must be considered for what they fairly teach to a person of ordinary skill in the art. In this case, when taken in the context of the surrounding text, Hagiuda merely discloses that the apparatus is excellent in portability “because no input unit such as a mouse is necessary” (e.g., see col. 11, lines 3-5; emphasis added). Similarly, Hagiuda discloses that the Hagiuda apparatus is excellent in portability “since editing operations can be accurately accomplished even using a small display screen” (see col. 11, lines 19-25; emphasis added).

Thus, when Hagiuda is considered as a whole for what it fairly teaches, Hagiuda discloses that the apparatus can be made portable by eliminating the input unit, such as a mouse, and reducing the size of the display screen.

However, in this case, it is respectfully submitted that merely eliminating an input unit and reducing the size of a display screen to improve portability have nothing to do with the aspect of efficiently using the memory capacity of a memory device. That is, a person of ordinary skill in the art clearly would not have been motivated by the alleged

purpose of Hagiuda (as outlined in the Office Action for improving portability) to arrive at the claimed invention which, among other things, efficiently uses memory space in a recording medium. It is settled law that there must be a reasonable motivation for combining the references and there must be a reasonable expectation of success (e.g., see M.P.E.P. § 2143).

Accordingly, Applicants respectfully submit that a reasonable motivation to combine the references has not been established, and therefore, that the rejection under § 103 should be withdrawn.

For at least the foregoing reasons, Applicants respectfully submit that it would not have been obvious to a person of ordinary skill in the art at the time of the invention to combine the prior art of record to arrive at the claimed invention, nor would any combination of the references arrive at the claimed invention.

Applicants respectfully request that the Examiner withdraw the rejection of claims 1, 3, 4, 7, 8, and 15 and permit these claims to pass to allowance.

B. Claims 2, 5, and 6 stand rejected under 35 U.S.C. § 103(a) as being obvious over Hagiuda, Ito, and further in view of Hatori.

Applicants submit that Hatori does not make up for the deficiencies of Hagiuda and Ito. That is, Hatori also does not disclose the claimed “storing, in a print designation file”.

Therefore, claims 2, 5, and 6 should be patentable over any combination of the cited references for reasons similar to those set forth above and withdrawal of this rejection respectfully is requested.

C. Claims 9 and 10 stand rejected under 35 U.S.C. § 103(a) as being obvious over Hagiuda, Ito, and further in view of Fukushima.

Applicants submit that Fukushima does not make up for the deficiencies of Hagiuda and Ito. That is, Fukushima also does not disclose the claimed “storing, in a print designation file”.

Therefore, claims 9 and 10 should be patentable over any combination of the cited references for reasons similar to those set forth above, and thus, withdrawal of this rejection respectfully is requested.

D. Claims 11 and 17 stand rejected under 35 U.S.C. § 103(a) as being obvious over Hagiuda and Ito.

For similar reasons to claim 1 above, Applicants respectfully submit that independent claims 11 and 17 are patentable over Hagiuda or Ito, either alone or in combination, and therefore, withdrawal of the rejection of claims 11 and 17 respectfully is requested.

E. Claims 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being obvious over Hagiuda and Ito.

For similar reasons to claim 1 above, Applicants respectfully submit that claims 12 and 13 are patentable over Hagiuda or Ito, either alone or in combination, and therefore, withdrawal of the rejection of these claims respectfully is requested.

F. Claim 14 stands rejected under 35 U.S.C. § 103(a) as being obvious over Hagiuda and Ito.

For similar reasons to claim 1 above, Applicants respectfully submit that claim 14 is patentable over Hagiuda or Ito, either alone or in combination, and therefore, withdrawal of the rejection of this claim respectfully is requested.

G. Claim 16 stands rejected under 35 U.S.C. § 103(a) as being obvious over Hagiuda, Ito, and further in view of Pearlman.

For similar reasons to claim 1 above, Applicants respectfully submit that claim 16 is patentable over Hagiuda, Ito, and Pearlman, either alone or in combination, and therefore, withdrawal of the rejection of this claim respectfully is requested.

IV. REJECTION UNDER 35 U.S.C. § 101

Claim 17 is rejected under 35 U.S.C. § 101 because the claimed invention allegedly is directed to non-statutory subject matter. Claim 17 is amended merely to

clarify the statutory subject matter to which the claim is directed. Applicants respectfully submit that claim 17 is directed to statutory subject matter, and therefore, respectfully requests that the Examiner withdraw this rejection.

V. NEW CLAIMS

Applicants add new claims 18-31 to provide more varied protection for the present invention. Specifically, Applicants add new claims 28-31 to define more thoroughly that the claimed invention reduces wasting of the memory capacity of the recording medium, avoids duplication of the image data for the still image to be printed, and does not redundantly store the image data of the image to be printed.

Applicants submit that new claims 18-31 are patentable over the cited references at least for reasons similar to those set forth above, as well as for the features recited therein, and therefore, respectfully request allowance of these claims.

VI. FORMAL MATTERS AND CONCLUSION

The Office Action objects to the specification because of informalities. The specification is amended above, as suggested by the Examiner. Therefore, the Examiner respectfully is requested to withdraw this objection.

Figures 3 and 6-8 have been amended to correct spelling errors. No new subject matter is added. The Examiner is requested to acknowledge receipt of and approve the

Replacement Sheets (4) attached herewith. For the Examiner's convenience, annotated sheets (4) showing the changes made also are attached herewith.

Applicants request that the Examiner acknowledge Applicants' claim to foreign priority and receipt of the priority documents filed on May 19, 2000.

In view of the foregoing, Applicants submit that claims 1-31, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

Serial No. 09/574,453
Docket No. FJ-2000-004-US

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The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

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FIG. 3

160

```
{  
  JOB_ID=01  
  PRINT_TYPE=STANDARD  
  QUANTITY=2  
  FILE_ID=01-0001  
  FILE_TYPE=STILL  
}
```

```
{  
  JOB_ID=02  
  PRINT_TYPE=STANDARD  
  QUANTITY=3  
  FILE_ID=01-0002  
  FILE_TYPE=STILL  
}
```

```
{  
  JOB_ID=03  
  TYPE=STANDARD  
  QUANTITY=2  
  FILE_ID=01-0003  
  FILE_TYPE=MOTION  
  FRAME_NUM=33  
}FRAME
```

```
{  
  JOB_ID=04  
  PRINT_TYPE=STANDARD  
  QUANTITY=1  
  FILE_ID=02-0003  
  FILE_TYPE=STILL  
}
```

FIG. 6

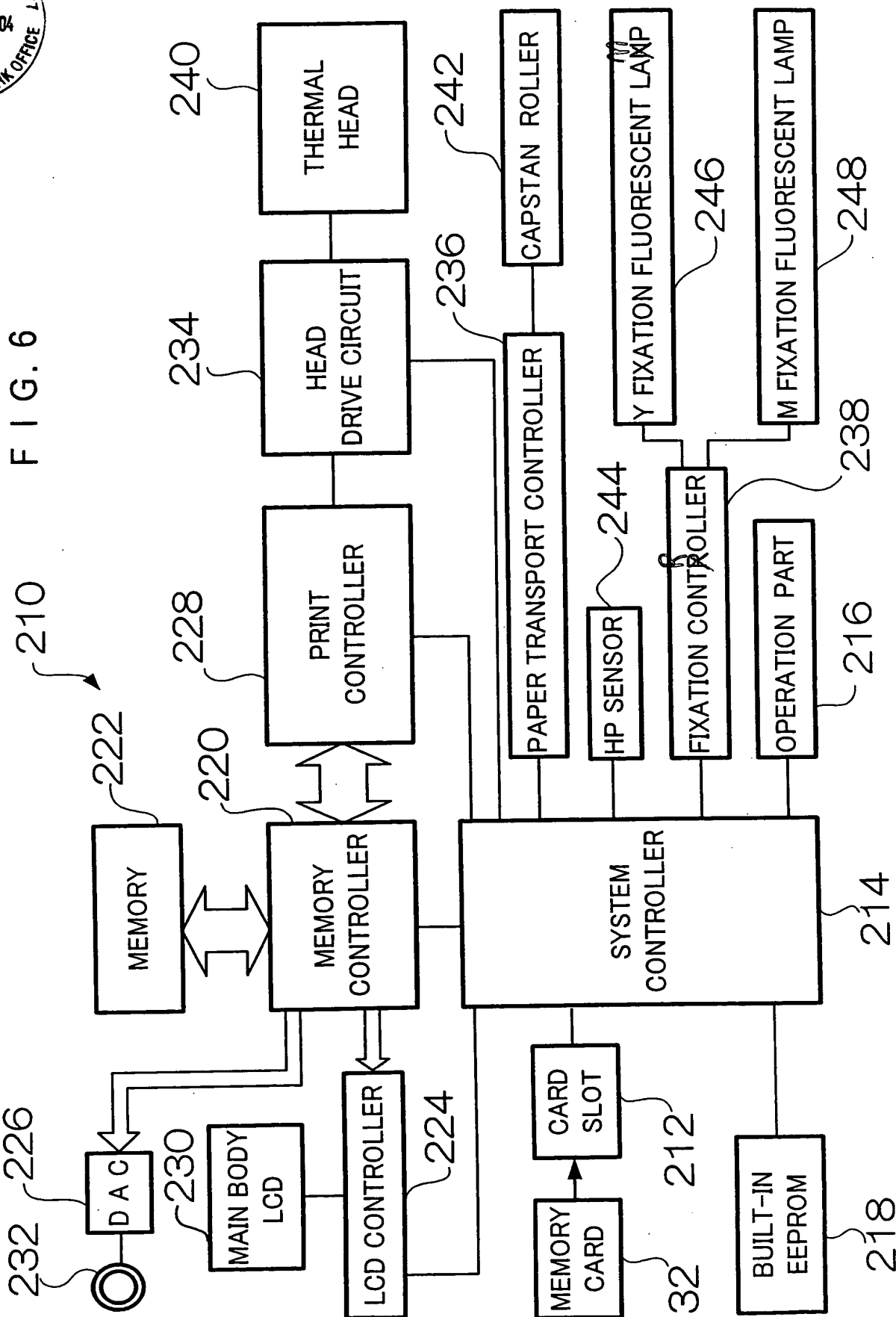


FIG. 7

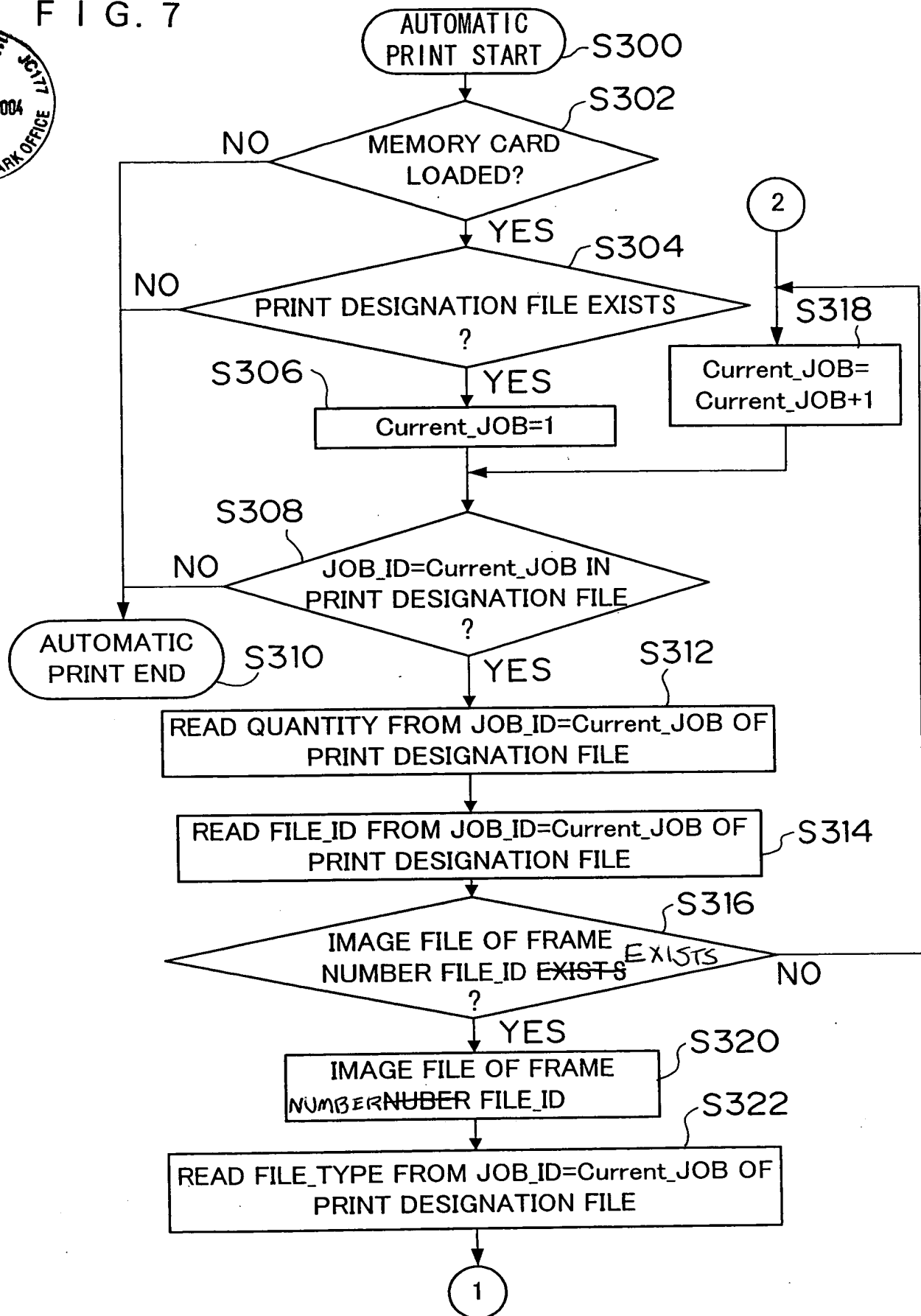


FIG. 8

